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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330

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EXAMINER
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SRIVASTAVA, VIVEK

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/870,296	<b>Applicant(s)</b> NASHIDA ET AL.	
	<b>Examiner</b> Vivek Srivastava	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1- 6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,311,011) in view of Hite (previously cited).**

***Regarding claims 1 and 4,*** Kuroda discloses a system for recording video signals onto a plurality of recording devices (see fig. 1). Kuroda discloses a user selects a program for recording which is recorded in a storage device 105 (see col. 4 lines 18 – 50) and thus discloses the claimed “*accepting a request to record and/or reserve a broadcast program*”. Kuroda further discloses determining or calculating the capacity and remaining capacity of the storage device, and in situations where the capacity is insufficient, a dialogue is presented to the user which warns the user of

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insufficient storage and to select another external device for storage (see col. 5 lines 60 – 65). It is noted Kuroda discloses the claimed *“determining whether it is possible to record a broadcast program requested to be recorded”* and the claimed *“connecting to an external device”*. Kuroda still further discloses providing a dialogue which instructs a user to select a storage device after determining the status of an external storage device (see fig, 22). It is noted that since dialogue inquires the recording status of the external device and provides the status of the external device i.e. “HDD 3.25”, “DVD NO DISK”, “VCR WRITE INHIBIT” and provides the signal to the external device for recording, Kuroda discloses the claimed *“issuing a recording request to an external device via said connection means in response to a negative result of determination”*.

While Kuroda discloses receiving and recording television programs, which inherently comprise commercials, Kuroda fails to teach the claimed “a user information management means for storing user information about each requesting origin, wherein a recording substitution means obtains advertising information appropriate fro a user attribute of the requesting origin via said connection means and inserting information in a recorded program.

In analogous art, Hite teaches a system and method for delivering targeted advertisements to consumers wherein the targeted commercials are stored locally and inserted and substituted for other commercials (see col. 13 line 58 – col. 14 line 32). Hite recognizes the importance substituting higher priority commercials for unconditionally preempt able commercials (see col. 3 lines 55 – 60). Hite further teaches *“It is another object of the present invention to provide viewers with*

*advertisements which are matched to the viewer's interests and needs". Hite further teaches "It is another object of the invention to provide such a system and process which will provide advertisers with less waste and greater cost effectiveness in delivering their messages only to those consumers who are desirable prospects".*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kuroda to include the claimed limitations for the benefit of ensuring higher priority advertisements are displayed and that targeted advertisements are directed to viewers to provide advertising which a user would find most interesting and which would also benefit the advertiser by providing advertisers with less waste and greater cost effectiveness.

**Claim 2** is met by the discussions in claim 1.

**Regarding claim 3**, the combination of Kuroda and Hite fails to disclose the claimed wherein said determination means generates a negative result when a failure in said system prevents a broadcast program from being recorded in said storage means.

Official Notice is taken it would have been notoriously well known to include redundant storage devices in situation wherein a given storage device is not working or failing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Kuroda and Hite to include the claimed limitation for the benefit of ensuing a program is recorded in situations of a recorder failing or not working.

**Regarding claim 5**, Kuroda discloses "*when the recorder is connected with the Internet, the video recorder may store video signals via World Wide Web in the*

*temporary storage device*" (see col. 12 lines 28 – 44). It is noted that World Wide Web records data from a plurality of external devices (plurality of users) and the substitution means is located upstream (World Wide Web) from the user and is records programs per a users request.

**Regarding claim 6**, Kuroda discloses user information i.e. the type of storage devices associated with each user station or "requesting origin" (see s105 in fig. 7 and fig. 22) wherein the recording substitution means records a broadcast program in a format i.e. HDD format, DVD format or VCR format for a user attribute of the requesting origin.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs  
6/24/06



**VIVEK SRIVASTAVA**  
**PRIMARY EXAMINER**